



Specification that is within the public domain is not contrary to the Patent Rules, and nor is the reference to domain names/URLs. We further respectfully note that the reference to two the Web sites in the Specification is not a trademark use and is not contrary to MPEP 601.01(v). Clarification by the Examiner is therefore respectfully requested.

We respectfully submit that the solicited claims fully satisfy 35 USC 112, second paragraph, and are not indefinite. We respectfully note that the solicited claims, as originally filed, conform to U.S. Patent Office practice, and are in full compliance with the Patent Rules and the Patent Laws. Accordingly, we respectfully request that the Examiner specify each aspect of the claim that the Examiner contends is indefinite so that it may be properly addressed.

In regard to the "informalities" cited by the Examiner, we note the following.

We respectfully submit that the language "maintaining at least one user account", "maintaining at least one vendor account", "maintaining at least one user trust account", "initiating said transaction for said transaction amount", and "maintaining a second user account" is not indefinite or unduly broad. These phrases are the recited steps of a method in a method claim. The claims need not limit their scope by identifying one particular entity for conducting this method, as any entity performing these steps will fall within the scope of the claims. This does not render the claims indefinite or unduly broad. It is clear from the Specification as originally filed that these method steps may be performed by, for example, a bank, a credit card company, or any business or financial institution.

Moreover, maintaining financial accounts is well known in the art and the claims need not be limited to one manner for maintaining these accounts. The Specification as originally filed makes clear that these accounts may be maintained, for example, by opening and

maintaining an account with a bank, a credit card company, or any business or financial institution capable of providing money accounts.

Because the Specification clearly discloses examples of a preferred embodiment that illustrates by whom method the steps of the claimed method may be performed and how, we respectfully submit that these method steps are not indefinite.

We respectfully submit that the language "at least a portion" is not indefinite and that the claims properly provided antecedent basis for the language "at least said portion". We respectfully note that the language "at least a portion of said transaction account" (not "said portion") in Claim 1, lines 7 and 9 is the first instance of a positively recited element in the claims. This positively recited element provides proper antecedent basis for each subsequent reference to "said portion of said transaction account" in the claims. Accordingly, we respectfully submit that there is proper antecedent basis for this language in the claims.

The plain and ordinary meaning of the language "at least a portion of the transaction amount" is that it is some amount more than zero and less than or equal to the full transaction amount. It may be anything in this range. This is neither vague nor indefinite. Nor is it overbroad, as it is clearly defined to be within a limited range. We respectfully note that it is not necessary to unduly limit the claims to a particular percentage of the transaction amount. How the portion is determined is not a necessary step in the claimed process and therefore it need not be recited in the claims.

We respectfully note that the language "one or more selected from the group consisting" used throughout the claims is standard *Markush* language and is therefore not indefinite.

We respectfully note that as expressly stated in the Manual of Patent Examining Procedure, applicants "can define in the claims what they regard as their invention essentially in

whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought." MPEP 2173.01.

Moreover, the Manual goes on to state that:

"The examiner's focus....is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available....Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners.... should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.... Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

**(A) The content of the particular application disclosure;
(B) The teachings of the prior art; and
(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." MPEP 2173.02**

Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. MPEP 2173.03.

Accordingly, we respectfully request that the rejection under 35 USC 112 be withdrawn.

We respectfully submit that the solicited claims are not anticipated by or obvious in light of the Hoffman (U.S. Patent No. 5,297,026) reference. Hoffman discloses a system for promoting accounting activity in which an providing a high rate of return for funds invested by the customer. Hoffman specifically requires that the funds to be invested are separate from the funds paid by the customer for a given purchase or transaction (Col. 2, lines 3-12; Co. 4, lines 30-54; Figure 1 and Col. 5, lines 42-54; Figure 2).

In the system disclosed in Hoffman, the offering entity documents all of the purchases made by the customer in a given time period and allows the customer to separately remit a percentage of the total amount separately paid for the purchases to be placed in an investment account.

This is not the claimed invention.

In sharp contrast to Hoffman, in the claimed invention at least a portion of the transaction amount is distributed to the trust account / investment vehicle. Hoffman clearly requires that the customer submit a separate amount and it is this amount that is placed in the investment account. Even though this separate amount is capped as a percentage of the total amount of the purchases made in a given period, it is still a separate remittance and is not any portion of the transaction amount, as in the claimed invention. This express language in the claims may not be ignored when reviewing the claims in light of the prior art.

Moreover, it is well established that in order to maintain a rejection under 35 U.S.C. §103, there must be some motivation in the reference to suggest the modification. See MPEP 2143. As expressly stated by the Court of Appeals for the Federal Circuit in In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990):

“Although a prior art device ‘may be capable of being modified to run the way [the patent applicant’s] apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’”[Emphasis added.]

The teaching or suggestion to make the claimed modification and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See MPEP 2143; In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Hoffman nowhere teaches or suggests modifying his system along the lines of the claimed invention, nor provides any motivation for one of ordinary skill in the art to do so. The system disclosed in Hoffman operates in a completely different manner than the claimed invention.

For example, Hoffman provides a review of one or more purchases over a given period of time, and it then calculates a percentage up to which the customer may afterwards contribute separately to an investment account. In sharp contrast, in the claimed invention, a portion of an actual transaction amount may be electronically distributed to the trust account / investment vehicle; the customer does not have to separately transfer funds.

This allows the system of the present invention to operate, for example, invisibly at a retail level. A user may use their credit card at a gas station or store, for example, and a portion of the transaction amount may be automatically transferred to the investment vehicle. This is not possible with the system disclosed in Hoffman and is nowhere suggested therein.

Accordingly, we respectfully request that the rejections under 35 USC 102(b) and 103(a) be withdrawn.

For the reasons set forth above, we respectfully submit that the solicited claims are now in proper condition for prompt allowance, which action is respectfully requested.



Respectfully submitted,

A handwritten signature in black ink, appearing to read "Frank A. Cona".

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